

REMARKS

Claims 1-8, 11-20, and 25 are pending in the present application.

At the outset, Applicants wish to thank Examiner Fortuna for the acknowledgement that Claims 1-8, 11-20, and 25 are free from the art and are allowable in view thereof. Reconsideration of the provisional obviousness-type double patenting rejections is requested in view of the following remarks.

The provisional obviousness-type double patenting rejection of Claims 7, 8, 11, and 12 over Claims 1-4 and 11 of US 10/490,120 is respectfully traversed.

Applicants note that the statement for reasons of rejection is a verbatim copy of the basis for rejection set forth in the Office Actions mailed December 16, 2008 and June 13, 2008. The fact that this rejection has not been updated in over a year is important as the claims in both applications have been modified during the course of their respective examinations.

Independent Claim 7 of the present application was amended on September 8, 2008, to be drawn to:

7. A method of producing a molded sheet comprising the steps of forming a wet web by a papermaking process using a raw material composition containing at least an oxidizable metal, a moisture retaining agent, and a fibrous material, dewatering the wet web, and drying the wet web, wherein said molded sheet has a content of components other than the fibrous material of 50% by weight or higher, a thickness of 0.08 to 1.2 mm, and a breaking length of 100 to 4000 m.

Claims 8, 11, and 12 of the present application, also subject to this provisional rejection, provide:

8. A method of producing a heat generating sheet including the step of impregnating a molded sheet with a solution of an electrolyte, the molded sheet being the molded sheet produced by the method according to claim 7.

11. The method of producing a molded sheet according to claim 7, wherein the fibrous material has a CSF of 600 ml or lower.

12. The method of producing a heat generating sheet according to claim 8, wherein the step of impregnating with a solution of an electrolyte is preceded or followed by the step of stacking two or more of the molded sheets.

Independent Claim 1 of US 10/490,120 was amended on November 18, 2008 and further amended by Examiner's amendment authorized on July 30, 2009, which was officially entered in the mailing of a Notice of Allowance on August 10, 2009, to be drawn to:

1. A process of producing a heat generating molded article, which comprises:
making an intermediate shaped product by a papermaking process from a raw material composition comprising at least
from 30 to 90 wt. % based on the weight of the raw material composition exclusive of water of an oxidizable metal powder having a particle size of 0.1 to 300 μm ,
from 0.5 to 60 wt. % based on the weight of the raw material composition exclusive of water of activated carbon,
from 2 to 80 wt. % based on the weight of the raw material composition exclusive of water of a fibrous material, and
water and
incorporating an electrolyte into the resulting intermediate product,
and
fabricating a heat generating molded article.

Claim 11 of US 10/490,120 was canceled on November 18, 2008, and Claims 2-4 of US 10/490,120, also used to form the basis of this provisional rejection, provide:

2. The process according to claim 1, which further comprises:
drying the intermediate shaped product before incorporating the electrolyte.

3. The process according to claim 1, wherein said incorporating the electrolyte is carried out by impregnating the intermediate shaped product with a solution of the electrolyte.

4. The process according to claim 2, wherein incorporating the electrolyte is carried out by impregnating the intermediate shaped product with a solution of the electrolyte.

Applicants submit that there are clear differences between the claims of the present application and the allowed claims of US 10/490,120, which extend far beyond simply a difference between making an “article” and making a “molded sheet” as alleged by the Examiner in the outstanding Office Action. For example, the cited and allowed claims of US 10/490,120 do not provide for or suggest the limitation of Claim 7 of the present application “wherein said molded sheet has a content of components other than the fibrous material of 50% by weight or higher, a thickness of 0.08 to 1.2 mm, and a breaking length of 100 to 4000 m”.

The Examiner is reminded that MPEP §2142 states:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. See *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971); *In re Tiffin*, 443 F.2d 394, 170 USPQ 88 (CCPA 1971), *amended*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. If, however, the examiner does produce a *prima facie* case, the burden of coming forward with evidence or arguments shifts to the applicant who may submit additional evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art. The initial evaluation of *prima facie* obviousness thus relieves both the examiner and applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to render obvious the claimed invention.

In the present application, the Examiner has clearly not met this initial burden. Specifically, in the outstanding Office Action the Examiner has not established how and/or

why the limitations in Claims 7, 8, 11, and 12 of the present application would be in any way obvious in view of Claims 1-4 of US 10/490,120.

Indeed, the Examiner is reminded that a proper obviousness analysis involves a three-step process, this first of which requires that Office personnel should establish a *prima facie* case of unpatentability considering the factors set out by the Supreme Court in *Graham v. John Deere*. See, e.g., *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) ("The PTO bears the burden of establishing a case of *prima facie* obviousness."); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966), requires that to make out a case of obviousness, one must:

- (A) determine the scope and contents of the prior art;
- (B) ascertain the differences between the prior art and the claims in issue;
- (C) determine the level of skill in the pertinent art; and
- (D) evaluate any evidence of secondary considerations.

Indeed, the Supreme Court in *KSR* reiterated that the framework for the objective analysis for determining obviousness under 35 U.S.C. §103 is stated in *Graham v. John Deere Co.*, which is set forth above. Further, the Office has set forth its "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*" in Federal Register, Vol. 72, No. 195, 57526-57535, which clearly has not been complied with in the current action (see MPEP §2144.08).

Applicants request withdrawal of this ground of rejection.

Applicants respectfully request that the provisional obviousness-type double patenting rejection of Claims 1-8, 11, 12, and 25 over Claims 12-23 of US 10/566,471 be held in abeyance until an indication of allowable subject matter in the present application. If necessary, a terminal disclaimer will be filed at that time. Until such a time, Applicants make no statement with respect to the propriety of this ground of rejection.

The Examiner is reminded that MPEP §804 indicates that: "If "provisional" ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer."

US 10/566,471 was filed on September 20, 2006, as a National Stage (371) of PCT/JP04/10800, filed on July 29, 2004, and remains pending. The present application is a National Stage (371) of PCT/JP03/07425, filed on June 11, 2003. Accordingly, the effective filing date of the present application is more than 13 months earlier than the effective filing date of US 10/566,471. Accordingly, this rejection should be withdrawn and this application passed to allowance with the withdrawal of the provisional obviousness-type double patenting rejection over US 10/490,120. Acknowledgment to this effect is requested.

Applicants submit that the application is in condition for allowance. Early notice to this effect is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 08/03)



Vincent K. Shier, Ph.D.
Registration No. 50,552